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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,651	06/26/2001	Hans-Heinrich Muller	31512-172587	9122

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EXAMINER

WALLS, DIONNE A

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 07/03/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/888,651

Applicant(s)

MULLER ET AL.

Examiner

Dionne A. Walls

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-15 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4, 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-5, 9-10 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Applicant's Admitted Prior Art.

Applicant has admitted that known, modern cigarette-making machines comprise a conveyor which includes a duct defining an elongated path arranged to receive a continuous shower of tobacco particles (corresponding to the claimed "flowable particulate material"), said particles being converted into an elongated stream by a stretch of an endless foraminous belt to which the particles are attracted to the underside. The underside of said belt constitutes one wall of the duct, and the duct includes stationary additional walls serving to flank the sides of the path beneath the lower reach of the belt and being in continuous contact with the moving tobacco particles. Applicant then states that attempts to ensure that the stationary walls of the duct will offer low resistance to sliding movement have included adding a coating of such walls with linings of tungsten carbide (corresponding to the claimed "ceramic material"; see US. Pat. No. 5,340,531, col. 5 line 65) (see instant specification pages 3-5)

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-10 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 629,853.

GB 629,853 discloses a garniture for cigarette-making machines which comprises a base 1 (corresponding to the claimed "conveyor") that accommodates a moving band (corresponding to the claimed "path") that carries tobacco, and includes a pair of side guides 11 (corresponding to the claimed "stationary/at least one/third walls bounding said path"), which are made of a ceramic-material lining bonded to steel blocks 12 (corresponding to the claimed "back support"). As evident from fig. 5, a duct defines the path for the tobacco-carrying band. And, while GB 629,853 may not specifically state that said tobacco is "*flowable* particulate material", one of ordinary skill in the art would have understood that such band is capable of carrying, not only tobacco material, in the form of a filler-rod, but also tobacco particulate material in flowable form because said band is structured to transport such material since it is surrounded by side-guides which would be able to contain even loose material such as flowable, particulate tobacco.

Regarding claim 6, while GB 629,853 may not specifically articulate that the lining has a thickness in the range of between .05-.5 mm, it does state that it is desirable to keep the thickness of the ceramic lining as small as possible. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to arrive at the claimed thickness ranges for the ceramic lining of the side-guides in an effort to optimize this thickness in order to lessen the possibility of defects developing in the interior of the ceramic material during its manufacture as suggested by GB 629,853 (page 2, lines 56-65).

Regarding claim 7, while there may be no clear articulation as to whether the ceramic lining of GB 629,853 is applied during its molten state or by spraying, this limitation is not deemed to impart any patentable weight to the claims since it articulates a *method* limitation (i.e. the manner in which ceramic is applied), not a *structural* limitation, when the claims are drawn to an apparatus. Apparatus claims must be *structurally* distinguishable from the prior art. See MPEP 2114.

Regarding claim 8, while GB 629,853 may not state that the surface adjacent the path has a consistency resembling that of the surface of an orange peel, it does state that the ceramic material is "fired" and ground to desired shape before it is bonded to the steel support (page 2, lines 92-95). This would suggest to one having ordinary skill in the art that the surface of the ceramic material would not be smooth and may have some irregularities (corresponding to the claimed "orange peel surface") that, based on the parameters of the operating system, could be adjusted or optimized to ensure efficient wear resistance.

3. Claims 1-5,7,9-11, 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 197 33 443 in view of Applicant's Admitted Prior Art.

DE 197 33 443 discloses a guide 1 (corresponding to the claimed "conveyor") for advancing a stream of tobacco particles (corresponding to the claimed "flowable particulate material"), comprising channel 7 (corresponding to the claimed "duct") defining a path for the tobacco particles and having sidewalls 14,16 flanking the channel, along with the lower stretch of foraminous belt 6 and inserts 4 which have marginal portions (corresponding to the claimed "two additional walls") (see figs; Note: U.S. equivalent 6,186,315). While DE 197 33 443 may not articulate that at least one of said walls consists at least in part of a ceramic material, Applicant has admitted that it is known to coat these walls with a lining of tungsten carbide, which is ceramic material. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the apparatus of DE 197 33 443 to include a tungsten carbide coating on the walls in order to offer low resistance to the sliding movement of the tobacco particles that flow by said walls as taught by Applicant on page 5 of the instant specification.

Regarding claim 7, while there may be no clear articulation as to whether the ceramic lining of DE 197 33 443 modified by Applicant's Admitted Prior Art is applied during its molten state or by spraying, this limitation is not deemed to impart any patentable weight to the claims since it articulates a *method* limitation (i.e. the manner in which ceramic is applied), not a *structural* limitation, when the claims are drawn to an

apparatus. Apparatus claims must be *structurally* distinguishable from the prior art. See MPEP 2114.

Allowable Subject Matter

4. Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Schmick (US. Pat. No. 6,186,315)
- Jayashankar et al (US. Pat. No. 5,340,531)


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne A. Walls whose telephone number is (703) 305-0933. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM (Every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.


Dionne A. Walls
June 27, 2002